



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,990	12/14/2001	Stevan A. Koistinen	21-1231	4975

7590 11/01/2002

Kaardal & Associates, PC
Attn: Ivar M. Kaardal
3500 South First Ave. Circle - Suite 250
Sioux Falls, SD 57105-5802

EXAMINER

WEINHOLD, INGRID M

ART UNIT	PAPER NUMBER
----------	--------------

3632

DATE MAILED: 11/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,990

Applicant(s)

KOISTINEN, STEVAN A.

Examiner

Ingrid M Weinhold

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 12-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

This application contains claims directed to the following patentably distinct species of the claimed invention: a) Figure 1; b) Figure 2; c) Figure 7; d) Figure 11; e) Figure 12.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone communication with Ivar Kaardal on 10/25/02 a provisional election was made without traverse to prosecute the invention of Embodiment a, Figure 1, claims 1-11, 17-19. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 12/14/01 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Specification

The disclosure is objected to because:

1) Page 8, line 20, the reference numeral "29" needs to be replaced with the numeral --32--.

Appropriate correction is required.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "44". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 8 is objected to because it depends from itself. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 17, there is no antecedent basis for "the return extents".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7, 9-11, 17, 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Quackenbush (5,072,542). Quackenbush shows a clip comprising a mounting portion having an inner face and an opposing outer face, a pair of side edges and a pair of end edges, an elongate longitudinal extent (G), a pair of transverse extents, each transverse extent extending from one of the end regions of the longitudinal extent in a generally transverse orientation to the longitudinal extent, a pair of return extents, each of the return extents extending from one of the transverse extents, each of the return extents extending towards each other, and a pair of free end extents, each of the free end extents extending from one of the return extents. The pair of transverse extents extend outwardly from the inner face of the longitudinal extent, each of the transverse extents having opposite end regions, a first one of the end regions of each of the transverse extents being joined to one of the end regions of the longitudinal extent. Each of the return extents extends generally parallel to the longitudinal extent, and extends from a second one of the end regions of one of the transverse extents. Each of the transverse extents and each of the return extents are arcuate. Each of the free end extents is arcuate such that a group of connected transverse, return and free end extents forms a portion of a circle. The end edges of

the mounting portion are located on one of the free end extents and a gap is formed between the end edge on the free end extent and the longitudinal extent. The clip additionally comprises a securing portion mounted on the mounting portion comprising a securing arm (16) for holding a portion of an ornamental item against the mounting portion, the securing arm having a first end mounted on the mounting portion and a second end being free of connection to the mounting portion. The securing arm generally converges toward the outer face at the second end (21) to form a channel for receiving a portion of the ornamental item.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 8, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quackenbush (5,072,542). Quackenbush shows all features claimed by the applicant's invention but does not specifically show the end extends being oriented perpendicular to the longitudinal extent or the distance of the gap being approximately one-half the distance of a farthest extent of the return extents from the longitudinal extent. This is the design choice of the applicant and is not a critical requirement of the invention. It would have been obvious to one of ordinary skill in the art at the time the

invention was made to have made the extents by Quackenbush longer and perpendicular in order to make the extents have an even tighter fit onto the object it is mounted to.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Clark	U.S. Patent	3,511,461
Lindblom	U.S. Patent	3,027,014
DeHart	U.S. Patent	4,417,712
Farr	U.S. Patent	2,076,941
Kahn	U.S. Patent	4,032,100

The above patents all show various support clips.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ingrid Weinhold whose telephone number is (703)-306-5762.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie A. Braun can be reached on (703) 308-2156. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-3686 for informal documents, (703) 872-9326 for formal regular communication and (703) 872-9327 for After Final Communications.

Art Unit: 3632

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Ingrid Weinhold
Patent Examiner
Technology Center 3600
Art Unit 3632



Ko-Hung Chan
Primary Patent Examiner
Technology Center 3600
Art Unit 3632